

REMARKS

In the Official Action, the Examiner withdrew a number of rejections, but maintained the rejections of various groups of claims as allegedly obvious over Tashiro et al., U.S. Patent No. 5,945, 240 and U.S. Patent No. 5,939,228. In so doing, the Examiner took the position that the recitation "chemically bonded directly to the support surface at its molecular end" was a "product-by-process" recitation that did not patentably define over the cited patents even though they did not meet this recitation.

Initially, applicant respectfully disagrees with the Examiner's characterization of the quoted phrase as being a "product-by-process" recitation". This type of recitation is present where the product is defined by process rather than structural recitations, such as where a claim recites "a product made by the steps of" That is not the case here. Claim 1 structurally recites how the polymer compound of the image-receiving layer is attached to the support surface and at what location. These are structural recitations that cannot be dismissed. Demonstrating this point is the decision in In re Garnero, 162 USPQ 221, 223 (CCPA 1969) where the court specifically stated:

...it seems to us that the recitation of the particles as "interbonded one to another by interfusion between the surfaces of the perlite particles" is as capable of being construed as a structural limitation as "intermixed", "ground in place", "press fitted", "etched", and "welded", all of which at one time or another have been separately held capable of construction, as structural, rather than process, limitations.

Although applicant respectfully disagrees with the characterization of the quoted language in claim 1 as being a "product-by-process" recitation, in an effort to advance the prosecution of the present application, applicant has amended claim 1 to use alternative

language which does not alter the scope thereof, but which avoids any implication of process steps.

With a proper understanding of the scope of the claims, those of ordinary skill in the art will recognize, as the Examiner apparently has, that neither of the Tashiro et al. patents disclose or suggest the present invention. Neither of the cited patents describes an image-receiving layer which contains a polymer compound having hydrophilic functional groups capable of forming chelates together with metal ions and is a straight-chain polymer compound that has a direct chemical bond to the support surface at its molecular end. This defined structure enables the image-receiving layer to have high water receptivity and good bonding strength to the support so that the lithographic printing plate of the present invention can exhibit high impression capacity while avoiding scumming as explained in the specification on pages 52 and 53.

Since the claims now of record unquestionably define over the teachings of the Tashiro et al. patents, applicant respectfully requests reconsideration and allowance of the present application.

As a final matter, applicant notes that the certified copies of the priority documents were provided with the previous response and applicant therefore requests that receipt of the same be acknowledged in the next Official Action.

Should the Examiner wish to discuss any aspect of the present application, he is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

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